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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,983	10/30/2003	John R. Woods	81168-306630	7854

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Intellectual Property Group of
Pillsbury Winthrop LLP
725 S. Figueroa Street, #2800
Los Angeles, CA 90017

EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,983

Applicant(s)

WOODS, JOHN R.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-36, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28-36, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 28-36, 55 and 56 are pending as amended on 20 October 2003, claims 1-27 and 37-54 being cancelled.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/375,840, filed 16 August 1999 and in prior Application No. 09/746,447, filed 6 December 2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and

(a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Drawings

3. The drawings are objected to because the reference number 18 is not described in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The use of the trademark STYROFOAM has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 28-36, 55 and 56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,797,051 (Woods '051 hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because Woods '051 anticipates the instant claims by claiming a hardenable flowable substance for application to a patch surface surrounded by an acoustic material having an irregular surface texture to form a layer of textured patch

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material on the patch surface, wherein the hardenable flowable substance is storable in a fluid-tight dispensing container and sprayable utilizing a propellant, the hardenable flowable substance comprising: 10 to 60% of a liquid base—including water and/or a solvent (Column 2 Lines 64 and 65, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—15 to 70% of a filler selected to form an extender or bodifier for the resulting patch material—including mixtures of limestone and mica (Column 4 Lines 40-42, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—1 to 50% of an adhesive binder selected to adhere the resulting patch material to the surface—including poly(vinyl alcohol) (Column 4 Lines 43-47, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—5 to 20% of a propellant—including dimethylether (Column 4 Lines 49-54, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—2 to 40% of a fibrous material selected to give the resulting patch material an irregular surface—including polyethylene particulates that do not decompose in the presence of volatile organic compound propellants (Column 2 Lines 56-62, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—2 to 40% of an anti-foaming agent—1 to 20% of a suspension agent—including carbonal (Column 5 Lines 31 and 32, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—a fungicide—at 0.05 to 5% (Column 6 Lines 40-48, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970)—and an antifreeze—including 1 to 10% ethylene glycol (Column 6 Lines 41-48, See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 CCPA 1970) wherein the hardenable flowable substance is initially stored in fluid state and is dispensable in the form of an aerosol spray from the fluid-tight container and, after being released and curing, forms a bumpy, irregular

surface texture that matches and is compatible with the acoustic ceiling material surrounding the patch.

7. Claims 28-36, 55 and 56 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/457,240 in view of US Patent 4,472,201 (Ochi hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a hardenable flowable substance for application to a patch surface surrounded by an acoustic material having an irregular surface texture to form a layer of textured patch material on the patch surface, wherein the hardenable flowable substance is storable in a fluid-tight dispensing container and sprayable utilizing a propellant, the hardenable flowable substance comprising: 20 to 70% of a liquid base—including water and/or a solvent—40 to 80% of a filler selected to form an extender or bodifier for the resulting patch material—including mixtures of limestone and mica—1 to 50% of an adhesive binder selected to adhere the resulting patch material to the surface—including poly(vinyl alcohol)—5 to 20% of a propellant—including dimethylether—2 to 40% of an aggregate material selected to give the resulting patch material an irregular surface—including rubber particulates that do not decompose in the presence of volatile organic compound propellants—1 to 10% of an anti-foaming agent—1 to 20% of a suspension agent—including carbonal—0.05 to 5% of a fungicide and 1 to 10% of an antifreeze wherein the hardenable flowable substance is initially stored in fluid state and is dispensable in the form of an aerosol spray from the fluid-tight container and, after being released and

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curing, forms a bumpy, irregular surface texture that matches and is compatible with the acoustic ceiling material surrounding the patch.

The copending application does not expressly claim polyethylene particulates as the aggregate.

Ochi teaches the use of foamed polyethylene as an aggregate for a hydraulic heat-resisting material (Column 3 Lines 45-53).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the foamed polyethylene as the aggregate in the composition of the copending application. The motivation to do so would have been to include a shrinkage-resisting agent and to make the composition a lighter weight (Ochi Column 3 Lines 45-53). Therefore, the claims of the copending application in view of Ochi fully encompass the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28, 32, 33, 35, 36, 55 and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,505,344 (Woods '344 hereinafter) in view of Ochi and US Patent 5,914,196 (Calvo hereinafter).

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Woods '344 teaches an acoustic ceiling patch or textured material in the form of a sprayable composition (Abstract) comprising 25 to 50% of a base comprising water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming agent and 0.20% of an antifreeze (Column 2 Lines 16-26 Column 4 Lines 10-39 and Column 4 Line 65 – Column 5 Line 35).

Woods '344 does not disclose expressly foamed polyethylene as the aggregate.

Ochi teaches the use of foamed polyethylene as an aggregate for a hydraulic heat-resisting material (Column 3 Lines 45-53).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the foamed polyethylene as the aggregate in the composition of Woods '344. The motivation to do so would have been to include a shrinkage-resisting agent and to make the composition a lighter weight (Ochi Column 3 Lines 45-53).

Woods '344 does not disclose expressly the use of a suspending agent or a fungicide.

Calvo discloses a water-based surface coating comprising fillers, a 0.1 to 6% of a suspending agent and a 0.1 to 10% of a microbicide (fungicide) (Column 1 Line 65 – Column 2 Line 3 and Column 4 Lines 45-63).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the suspending agent of Calvo in the composition of Woods

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'344. The motivation to do so would have been to keep the fillers in suspension (Calvo Column 2 Lines 38-41).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the microbicide of Calvo in the composition of Woods '344. The motivation to do so would have been to inhibit the growth of microbes such as bacteria and fungi (Calvo Column 2 Lines 51-55).

10. Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over US Woods '344 hereinafter in view of Ochi and Calvo in further view of US 4,450,253 (Suk hereinafter).

Woods '344, Ochi and Calvo teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising 25 to 50% of a base comprising water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an foamed polyethylene aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming agent and 0.20% of an antifreeze a suspending agent and a fungicide as described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of the defoaming agent at 1 to 20% of the composition.

Suk discloses an aerosol paint composition comprising up to about 2% of an antifoam agent (Column 7 Lines 40-49).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the level of antifoam of Suk in the composition of Woods '344,

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Ochi and Calvo. The motivation to do so would have been to permit the ready release of dissolved gasses upon spraying (Suk Column 7 Lines 40-49).

11. Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over US Woods '344 hereinafter in view of Ochi and Calvo in further view of US 5,500,456 (Hughett hereinafter).

Woods '344, Ochi and Calvo teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising 25 to 50% of a base comprising water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an foamed polyethylene aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming agent and 0.20% of an antifreeze a suspending agent and a fungicide as described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of the antifreeze at 1 to 10% of the composition.

Hughett discloses an aerosol tire sealer comprising 2 to 8% of an alkylene glycol or propylene glycol antifreeze (Column 5 Lines 45-64)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the level of antifreeze of Hughett in the composition of Woods '344, Ochi and Calvo. The motivation to do so would have been to allow the spray to be useful below 25 degrees F (Hughett Column 3 Lines 50-55).

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12. Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo as applied to claims 28, 29, 32, 33, 35, 36, 55, and 56 described above in further view of US Patent 4,005,038 (Minkoff hereinafter).

Woods '344, Ochi and Calvo combine to teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising a base comprising water and/or a solvent, of a filler, a binder, a polyethylene aggregate, a propellant, a defoaming agent, an antifreeze and a suspending agent described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of ethylene glycol as an antifreeze.

Minkoff discloses a paint composition including ethylene glycol (Column 3 Lines 5-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use ethylene glycol as an antifreeze in the composition of the combined teachings of Woods '344, Ochi and Calvo. The motivation to do so would have been to protect the composition from low temperatures during storage and shipment.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached Monday-Thursday.

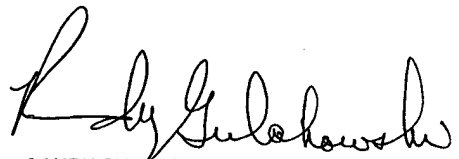
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is (571) 273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700